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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,620	12/05/2001	Makoto Ozeki	1422-0507P	8140

2292 7590 06/25/2003

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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/25/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,620

Applicant(s)

OZEKI ET AL.

Examiner

Humera N. Sheikh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003 (paper no.8).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Status of the Application

Receipt of the Amendment and the request for an extension of time (1 month), both filed 03/04/03 and the Supplemental Amendment filed 04/01/03 is acknowledged.

The 35 U.S.C. 112 second paragraph rejections have been withdrawn.

Claims 1-28 are pending. Claims 1-5 have been amended. New claims 6-28 have been added. Claims 1-28 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakuda et al. (US Pat. No. 5, 501,866).

Kakuda discloses a caffeine stimulation inhibitor and a method for inhibiting caffeine stimulation comprising theanine extracted from tea leaves and/or a substance having theanine as its main active ingredient, wherein the caffeine stimulation inhibitor is added to beverages and foods (see reference column 2, lines 38-46); abstract and

Art Unit: 1615

claims. The composition is taught to be particularly useful for people who are hypersensitive to caffeine and/or desire to suppress the action of caffeine (including those who desire to drink tea and coffee without impairing sleep) to allow them to consume caffeine-containing beverages or foods without worry over its effects (col. 2, lines 1-62). Kakuda discloses that the theanine may be crude or refined theanine and the theanine content in the caffeine stimulation inhibitor is preferably 10 to no more than 500 times the amount of caffeine ingested (col. 2, lines 47-51). The caffeine stimulation inhibitor is preferably used as an additive of beverages and foods and may also be absorbed in the form of tablets, capsules, granules or syrup (col. 2, lines 63-67). Kakuda discloses a method for inhibiting caffeine stimulation wherein the caffeine stimulation inhibitor is also in powder and liquid form (claims 2 and 4). At column 6, lines 25-29 (claim 11) Kakuda discloses a food or beverage product comprising beverages containing caffeine and theanine in an amount between 10 and 500 times greater than the amount of caffeine contained in said foods or beverages. Kakuda also discloses various experiments and studies demonstrating the antagonistic action of theanine (col. 3-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1615

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakuda et al. (US Pat. No. 5, 501,866) as applied to claims 1-4 above, and further in view of Ekanayake et al. (US Statutory Invention Registration H1628).

Kakuda, as discussed above, teaches a caffeine stimulation inhibitor and a method for inhibiting caffeine stimulation comprising theanine extracted from tea leaves and/or a substance having theanine as its main active ingredient, wherein the caffeine stimulation inhibitor is added to beverages and foods (see reference column 2, lines 38-46); abstract and claims. The composition is taught to be particularly useful for people who are hypersensitive to caffeine and/or desire to suppress the action of caffeine (including those who desire to drink tea and coffee without impairing sleep) to allow them to consume caffeine-containing beverages or foods without worry over its effects (col. 2, lines 1-62). The caffeine stimulation inhibitor is preferably used as an additive of beverages and foods and may also be absorbed in the form of tablets, capsules,

Art Unit: 1615

granules or syrup (col. 2, lines 63-67). Kakuda disclose various experiments and studies demonstrating the antagonistic action of theanine (col. 3-5).

Kakuda is deficient only in the sense that he does not teach sugars, minerals and acids in the caffeine stimulation inhibiting composition.

Ekanayake teaches a tea extract composition containing high levels of theanine, various sugars, sweeteners, minerals, acids and flavorants (see reference column 1, line 50 through col. 2, line 64); (col. 3, lines 50 through col. 5, line 64).

The theanine composition contains various *sugars*, such as sucrose, glucose, syrups – refiners' syrup, corn syrup, *maltose* and high maltose syrups and mixtures thereof. Sweeteners include sugars, artificial sweeteners, sugar alcohols and other naturally sweet compounds (col. 3, lines 50-67).

Suitable edible acids include any organic or inorganic acid, such as citric, fumaric, acetic, *tartaric* and the like (col. 5, lines 18-33).

Suitable *metal salts* include alkali or alkaline earth metal salts of citric acid, such as sodium potassium or calcium citrate. Other salts such as potassium tartrate, sodium lactate, sodium hydrogen phosphate and related metal salts can be used (col. 5, lines 34-45).

Flavorants include natural and synthetic fruit flavorings, botanical flavorings and mixtures thereof (col. 4, lines 3-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kakuda with Ekanayake since

Art Unit: 1615

Ekanayake teaches a theanine containing composition comprising various sugars, minerals, acids and flavorings because they could aid in obtaining a product that is less astringent and less harsh in tastes and provides all of the benefits of green tea solid mixtures and similarly, Kakuda teaches a composition comprising theanine extracted from tea leaves and/or a substance having theanine as its main active ingredient, wherein the caffeine stimulation inhibitor is added to various beverages and foods. The expected result would be a highly effective theanine composition for the inhibitory effects of caffeine.

Response to Arguments

Applicant's arguments filed 03/04/03 have been fully considered but they are not persuasive. The applicant argued regarding the 35 U.S.C.102(b) anticipatory rejection of Kakuda (US '866) stating, "Kakuda does not disclose a *sleep-promoting composition or a method for promoting sleep* but only discloses a method for inhibiting the effects of caffeine and that impairing sleep is not the same as a sleep-promoting composition. The effects of sleep-promoting are never taught or suggested by Kakuda."

These arguments have been fully considered, but were not found to be persuasive. Kakuda disclose a composition that is generic to the issue of sleep-promotion. Furthermore, the particular sleep disorder does not impart patentability since the affect desired by the applicant has been shown to be obtained by the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

Art Unit: 1615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns

June 23, 2003


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600